

Application No.: 09/682,187
Amendment dated: March 24, 2004
Reply to Office Action of December 24, 2003

b) Remarks

The Patent Office objected to the drawings and specification. The specification has been amended in accordance with the Patent Office requirements as shown above. The amended specification makes it unnecessary to correct drawings. Care has been taken not to introduce new matter.

Claims 1-3, 6-8, 10-14, 16-18, 20, 22-32 are pending in this application. Claims 1, 6-8, 12, 20, 22-25, and 30 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,483,103 to Engelhardt et al. ("Engelhardt"). Claims 26 and 27 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt, and further in view of U.S. Patent No. 6,462,345 to Simon et al. ("Simon"). Claims 2, 3, 10, 11, 13, 14, 16-18, 28, 29, 31, and 32 have been objected to as being dependent upon a rejected base claim.

Rejection under 35 U.S.C. 102(e).

Applicant respectfully points out that Engelhardt cannot be used for a rejection under 35 U.S.C. 102(e), because Applicant invented the present claimed invention before the effective date of Engelhardt and because the translation of the certified copy of German priority application has been made of record on August 2, 2001.

The German priority application DE 100 38 049.2 was filed on August 2, 2000, which is before the February 15, 2001, effective filing date of Engelhardt. Under 35 U.S.C. 104, prior invention can be established in a WTO country, if the invention was made after December 8, 1993. Filing of a German patent application in Germany on August 2, 2000, proves that the Applicant invented the present invention at least as of the German filing date. Proof of that German filing date was submitted in this case on August 28, 2001, when a certified copy of German priority application DE 100 38 049.2 was filed. Therefore, in accordance with 35 U.S.C. 104, the established date of invention is at least as early as August 2, 2000, predating the February 15, 2001, effective filing date of Engelhardt.

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The Examiner stated that Applicant cannot rely upon the certified copy of German priority application to overcome this rejection because its translation has not been made of record. Applicant respectfully disagrees. The application as filed in the United States Patent and Trademark Office on August 2, 2001, is a translation of the German priority application.

The statement that the translation of the certified copy is accurate will be filed on March 25, 2004.

Therefore, Engelhardt should be withdrawn as a 102(e) reference in the case. Allowance of Claims 1, 6-8, 12, 20, 22-25, and 30 is respectfully requested.

Rejection under 35 U.S.C. 103(a).

Applicant respectfully points out that Engelhardt does not qualify as 103(a) prior art for two reasons.

The first reason is that Engelhardt is not prior art under 35 U.S.C. 102, as described above.

The second reason is that under 35 U.S.C. 103(c) Engelhardt cannot be used for a 103(a) rejection, because Engelhardt was introduced by the Examiner as 103(a) prior art under 102(e) and because, at the time the Applicant's invention was made, the invention and Engelhardt had a common assignee, namely, Leica Microsystems Heidelberg GmbH.

Therefore, Engelhardt should be withdrawn as a 103(a) reference in the case. Allowance of Claims 26 and 27 is respectfully requested.

Objection for dependence upon a rejected base claim.

Applicant respectfully submits that the 102(e) and 103(a) rejections be withdrawn for reasons described above. This withdrawal will remove the grounds for this objection.

Withdrawal of objections to Claims 2, 3, 10, 11, 13, 14, 16-18, 28, 29, 31, and 32 is respectfully requested.

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Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is strongly encouraged to contact the undersigned to discuss the pending Claims.

Respectfully submitted,

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